

U.S. Application No.: 10/635,486  
Submission for RCE

Attorney Docket No.: FSF-031421

## REMARKS

Claim 1 has been cancelled, and dependent claims 2-20 have been amended to depend either directly or indirectly from claim 21. Claims 12 and 18 have been cancelled. Claim 21 is amended to include the features such as a bisphenol reducing agent and a non-photosensitive organic silver salt containing silver behenate. The support for these limitations can be found on page 101, lines 23-24 and claim 12 (for a bisphenol reducing agent) and on page 111, lines 3-4 (for organic silver salt containing silver behenate).

### I. Response to Claim Rejection under 35 U.S.C. § 102 and §103

#### **A. Rejections over Kawahara, et al. (US Patent No. 6,436,626)**

Claim 21 has not been rejected over Kawahara, et al. Now that dependent claims 2-20 have been amended to depend from claim 21, all the pending claims should be allowable over Kawahara, et al.

#### **B. Rejection over Yoshioka (US 2003/0235794 A1)**

Claim 21 has been rejected under 35 U.S.C. § 102(e) as anticipated by Yoshioka.

A certified translation of the Japanese patent application to which the present application claims priority is hereby submitted. Accordingly, Yoshioka is no longer available as prior art under 35 U.S.C. § 102(e).

#### **C. Rejection over Toya, et al. (US Patent No. 5,998,127)**

Claim 21 has been rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Toya, et al.

With respect to the halogen composition of the photosensitive silver halide, as disclosed in Toya, et al. in column 3, lines 52-54, "[m]ost preferred

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is silver iodobromide preferably having a silver iodide content of 0.1 to 40 mol%, especially 0.1 to 20 mol%," which is far smaller an amount than the inventive range of 80 to 100 mol% as recited in claim 21. Toya, et al. also discloses that the photosensitive silver halide is preferably used in an amount of 0.01 to 0.5 mol per mol of the organic silver salt (i.e. 1-50 mol%) (see column 5, lines 34-38). An organic silver salt may be prepared, as one of options, by adding the already prepared photosensitive-silver halide at any timing during preparation of an organic silver salt (see column 5, lines 44-46).

Although some of the limitations of the invention overlap the ranges disclosed in Toya, et al., the combination of the limitations recited in claim 21 is neither taught nor suggested by Toya, et al.

The silver iodobromide emulsion used in the specific examples disclosed in columns 17-22 of Toya, et al. has only 8 mol% of AgI in the core and 2 mol% of AgI in the shell, which is far smaller an amount than the inventive range of 80 to 100 mol% as recited in claim 21. The particle size of silver iodobromide used in the specific examples of Toya, et al. is 70 nm or 50 nm, and the amount of silver halide to be used (calculated as silver) is 10 to 27 mol% per mol of the organic silver salt. Organic silver salt and silver halide are prepared separately and admixed thereafter in the specific examples. Therefore, the organic silver salt disclosed in Toya, et al.'s specific examples is different from the organic silver salt prepared in the presence of silver halide as claimed in claim 21.

One of the specific features of the present invention is the organic silver salt prepared in the presence of photosensitive silver halide. The

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organic silver salt prepared in this manner has silver halide uniformly dispersed compared to silver halide particles in the organic silver salt prepared in a different method as shown in the 37 C.F.R. § 1.132 declaration submitted on February 17, 2005.

Thanks to this uniformity of silver halide in organic silver salt, unexpectedly superior results are obtained in that high-iodide silver halide having a smaller particle size achieves higher sensitivity, and smaller amount of silver iodide (when particle size is the same) achieves higher  $D_{max}$ . This results are shown in the 37 C.F.R. § 1.132 declaration submitted on July 21, 2006.

Toya, et al. neither teaches nor suggests that, by using a high-iodide-containing silver halide emulsion, high sensitivity can be obtained with the particular range of silver halide particle size as claimed in the invention, and that high density can be obtained with the particular range of silver halide coating amount as claimed.

## II. 37 C.F.R. § 1.132 declaration submitted on July 21, 2006

The Examiner argues that the declaration submitted on July 21, 2006 is not commensurate with the scope of the claimed invention. In response, claim 21 has been amended to limit a reducing agent and an organic silver salt to a bisphenol reducing agent and an organic silver salt containing silver behenate, respectively. Accordingly, the declaration fully supports the unobviousness of the present invention as claimed in claim 21.

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**III. Conclusion**

In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



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